

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:

Singhal, et al.

Serial No.: 10/809,223

Filed: 3/25/2004

Examiner: Holder

Group Art Unit: 2621

Confirmation No. 6554

Electronically Filed
September 2, 2008

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

This correspondence is filed in response to the office
action of May 2, 2008.

REMARKS

Claims 1, 2, 3, 9-14, 20, and 21 are presently pending. Claims 5-8, and 15-19 are cancelled without prejudice. Assignee respectfully requests pre-appeal brief review of the rejections.

Claims 1, 9, and 20 were rejected under 35 U.S.C. 103(a) as being obvious from Ritchey. Claim 9 recites, among other limitations, "wherein audio decoding comprises MPEG 1 level 3 decoding processes".

Examiner has indicated that "Ritchey teaches the use encoding and decoding of MPEG video it would have been obvious at the time the invention was made that MPEG standards applies to both video of and audio processed with the device of Ritchey. It is suggested in Ritchey specification that several formats are applicable such 'NTSC, PAL, SECAM, IDTV, HDTV, or the like' is processed within the device which inherently supports MPEG 1 level 3 or the like". Office Action at 2.

Assignee respectfully traverses the rejection. Even if it is true that "MPEG standards" are applicable to "both video ... and audio processed with the device of Ritchey", it does not follow that Ritchey teaches "audio decoding comprises MPEG 1, Level 3 decoding processes". "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Even if it is true that "MPEG standards" are applicable to "both video ... and audio processed with the device of Ritchey",

there is no teaching in Ritchey that MPEG standards must be used.

Additionally, Assignee respectfully submits that formats such as "NTSC, PAL, SECAM, IDTV, HDTV, or the like" do not inherently teach MPEG 1 level 3 or the like. NTSC, PAL, SECAM, IDTV, and HDTV are *video display* standards, while MPEG 1 level 3 is an *audio compression* standard.

Thus, for at least the foregoing reasons, Assignee respectfully requests that the rejections to claims 1, 9, and 20 be withdrawn.

For at least the foregoing reasons, each of the pending claims are in a condition for allowance and such a notice is respectfully requested. Please charge any required fees not paid herewith or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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September 2, 2008

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 15465US01	
I hereby certify that this correspondence is being electronically filed with United States Patent and Trademark Office on September 2, 2008 Signature _____ /Mirut P. Dalal/ Typed or printed Name _____ Mirut P. Dalal	Application Number 10/809,223	Filed March 25, 2004	
	First Named Inventor Singhal		
	Art Unit 2621	Examiner Holder, Anner N.	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 44,052</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
		_____ /Mirut P. Dalal/ Signature	
		_____ Mirut P. Dalal Typed or printed name	
		_____ (312) 775-8063 Telephone number	
		_____ September 2, 2008 Date	
<p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			